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**COMBINED TRANSMITTAL OF APPEAL BRIEF TO THE BOARD OF PATENT
APPEALS AND INTERFERENCES & PETITION FOR EXTENSION OF TIME
UNDER 37 C.F.R. 1.136(a) (Large Entity)**

Docket No.
TPP 31386

In Re Application Of: Ola OLOFSSON et al

MAY 12 2005

Application No.

09/806,941

Filing Date

May 21, 2001

Examining
P. Tran

Customer No.

24257

Group Art Unit

3637

Confirmation No.

9543

Invention:

**FLOORING MATERIAL COMPRISING BOARD SHAPED ELEMENTS WHICH ARE JOINED
VERTICALLY BY MEANS OF SEPARATE ASSEMBLY PROFILES**

COMMISSIONER FOR PATENTS:

This is a combined Transmittal of Appeal Brief to the Board of Patent Appeals and Interferences and petition under the provisions of 37 CFR 1.136(a) to extend the period for filing an Appeal Brief.

Applicant(s) hereby request(s) an extension of time of (check desired time period):

☐ One month ☒ Two months ☐ Three months ☐ Four months ☐ Five months

from: March 13, 2005

Date

until:

May 13, 2005

Date

The fee for the Appeal Brief and Extension of Time has been calculated as shown below:

Fee for Appeal Brief: \$500.00

Fee for Extension of Time: \$450.00

TOTAL FEE FOR APPEAL BRIEF AND EXTENSION OF TIME: \$950.00

The fee for the Appeal Brief and extension of time is to be paid as follows:

☒ A check in the amount of **\$950.00** for the Appeal Brief and extension of time is enclosed.

☐ Please charge Deposit Account No. _____ in the amount of _____

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☒ Any additional filing fees required under 37 C.F.R. 1.16.

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TO THE COMMISSIONER FOR PATENTS:

This combined Transmittal of Appeal Brief to the Board of Patent Appeals and Interferences and petition for extension of time under 37 CFR 1.136(a) is respectfully submitted by the undersigned:

 Reg No 45 044
Signature

Dated: May 12, 2005

Thomas P. Pavelko, Esquire

Registration No. 31,689

STEVENS, DAVIS, MILLER & MOSHER, L.L.P.

1615 L Street, N.W., Suite 850

Washington, D.C. 20036

Telephone: (202) 785-0100

Facsimile: (202) 408-5200 or (202) 408-5088

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Before the Board of Patent Appeals and Interferences

In re the Application of

Ola OLOFSSON et al.

Group Art Unit: 3637

Serial No.: 09/806,941

Examiner: P. Tran

Filed: May 21, 2001

For: FLOORING MATERIAL COMPRISING BOARD SHAPED ELEMENTS WHICH ARE
JOINED VERTICALLY BY MEANS OF SEPARATE ASSEMBLY PROFILES

APPEAL BRIEF

Thomas P. Pavelko, Esquire
Registration No.: 31,689
STEVENS DAVIS, MILLER & MOSHER L.L.P.
1615 L Street, N.W., Suite 850
Washington, D.C. 20036
Telephone: (202) 785-0100
Facsimile: (202) 408-5200

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Date: MAY 12, 2005



I. REAL PARTY IN INTEREST

The real party in interest is the assignee of the inventors, Pergo (Europe) AB, a company of Sweden, having a principal address of Strandridaregatan 8, S-231 25 Trelleborg, Sweden.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences known to Appellants, Appellants' legal representative or the assignee, which will directly affect, or be directly affected by, or have a bearing on, the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1-7, 11-14 and 20-24 stand rejected. Claims 8-10 and 15-19 have been cancelled. This is an appeal of the rejection of each of the rejected claims, i.e., 1-7, 11-14 and 20-24.

IV. STATUS OF AMENDMENTS

A single Amendment (amending claims 1-7 and 11-14, 20 and 21) was filed on January 13, 2005, and as this Amendment was in response to a non-final rejection, it is believed that the amendments were entered as a matter of right.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The claims are directed to a floor which is joined by the use of a joining profile of a particular shape, as well as to the joining profile itself.

A. Independent Claim 1

Claim 1 recites a floor formed from a plurality of floor boards (1) with edges (2), a decorative upper surface (3), a lower side (5) which are joined by joining profiles (10). The particularly claimed shape of the edges and joining profiles are depicted, for example in Fig. 1b, and includes a notch (2'), a shoulder (30) having a distal end (32). A groove (4) on an edge is arranged parallel to the edge.

The joining profile includes parallel lips (11) arranged in pairs, extending in the same direction, such that when inserted into said groove, do not extend beyond said lower side of the floor boards. The lips are connected to each other by a middle section of the joining profile (12). The joining profile also includes a central cheek section (13), being a first resilient cheek and a second independently resilient cheek (13' and 13''), each having a width and terminating at one tongue (14' and 14'').

The shapes of the edges of the floor boards and joining profiles are designed so that when each tongue is received a notch, adjacent floor boards are fixed in a vertical direction and a distance between a plane (P) including the distal end of the edge and said distal end of the shoulder (32) is greater than the width one or more of the cheeks. This feature is supported in the paragraph added by the Amendment After Final of April 30, 2004 (entered through the Request for Continued Examination of June 1, 2004) to page 6.

B. Independent Claim 13

Independent claim 13 is directed to the shape of the joining profile itself, independent of the floor boards. As recited by claim 13, the joining profile (10) includes two upstanding lips (11) extending parallel to each other in the same direction (Fig. 1a; and page 5, lines 24-25). The lips are disposed at opposite ends of and perpendicular to a planar, longitudinally extending middle section (12) (page 5, lines 28-29) having a midpoint, such that the middle section terminates with the upstanding lips (Fig. 1a). The joining profile is formed from thermoplastic, polystyrene, polyvinyl chloride, or acrylonitrile-butadiene-styrene copolymer. See claim 1, as originally filed and the first full paragraph of page 3.

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

A. Claims 2-5, 7, 11, 12, 20 and 21 stand rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim that which is considered the invention.

B. Claims 1-5, 7, 11, 12, 20 and 21 stand rejected under 35 USC §103(a) as being unpatentable over Svenska in view of Glover et al., Porter and Larrea.

C. Claims 6, 13 and 14 stand rejected under 35 USC § 103(a) as being unpatentable over Svenska in view of Glover et al.

D. Claims 22 and 24 stand rejected under 35 USC § 103(a) as being unpatentable over Svenska in view of Glover et al.

E. Claim 23 stands rejected under 35 USC § 103(a) as being unpatentable over Svenska in view of Glover et al.

VII. ARGUMENT

A. Claims 2-5, 7, 11, 12, 20 and 21 stand rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim that which is considered the invention.

In the Office Action of August 13, 2004, the Examiner rejected claims 2-5, 7, 11, 12, 20 and 21 as the preambles were not consistent with the preamble of claim 1, from which the rejected claims depend. In response, the claims have been amended to moot this rejection.

B. Claims 1-5, 7, 11, 12, 20 and 21 stand rejected under 35 USC §103(a) as being unpatentable over Svenska in view of Glover et al., Porter and Larrea.

Claims 1-5, 7, 11, 12, 20 and 21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Svenska (SE 8202375-5) in view of Glover et al (U.S. Patent 5,054,256), Porter (U.S. Patent 4,671,038) and Larrea (U.S. Patent 4,435,935). Although the Examiner acknowledges (on page 4 of the Office Action), “Svenska does not show the joining profile and the lips when inserted into the groove, does not extend beyond the lower side, the joining profile is provided with a cheek section which is comprised by first and second independently resilient cheeks, which cheeks are provided with one tongue each, whereby each tongue is received by one notch each so that the adjacent floor boards are guided in a vertical direction, a distance between the distal end of the edge and the distal end of the shoulder is greater than the width of at least one of the cheek.” Svenska also lacks other teachings of the claimed invention.

i. Independent Claim 1

For example, independent claim 1 defines the floorboards as including “a decorative top surface,” which is nowhere found in the Svenska reference. In addition, claim 1, as amended, further recites that the “lips are parallel and each extend in the same direction” By contrast, Svenska clearly teaches that the lips are not parallel, but form an angle “V” of approximately 86°, which means that the lips are not parallel to one another; See, the first full paragraph on page 3 of the English language translation of Svenska, as well as Fig. 2 of Svenska. The reliance on the secondary reference Glover et al. does not correct the foregoing deficiencies of Svenska. Although the examiner attempts to interpret the teaching of Glover et al (Figs. 5C-7) as showing a profile with a central cheek section which is divided by first and second independently resilient cheeks (104, 105), these cheeks ignore the feature of claim 1 that each tongue terminates at its respective cheek and further that each tongue is received by said notch so that adjacent floorboards are fixed in a vertical direction. As clearly shown in Fig. 5C of Glover et al., the tongue is not received by said notch nor is there any indication that the panel system of Glover et al. even contains a notch into which the tongue is received. Clearly, the purported tongues of Glover et al. do not terminate at their respective cheeks. Accordingly, any attempted combination of Svenska and Glover et al frustrates the intended purpose and structure of each document and does not establish a *prima facie* case of obviousness for the claimed invention because a worker having ordinary skill in the art would not have been impelled to do what the Applicants have done, i.e., to formulate a structure which is not suggested by the combination of Svenska and Glover et al.

Furthermore, the combination with Larrea and/or Porter does not correct the foregoing deficiencies since Larrea (Fig. 1) does not contain the limitation recited in the present claims, i.e., a joining profile having upstanding and parallel lips extending in the same direction connected to a central section having an upstanding cheek portion. At best, Larrea only shows a mere clip having only part of the claimed structure and there is no evidence that one having ordinary skill in the art would have combined Larrea with the other references as suggested by the examiner.

Porter is even more further removed in not teaching a structure corresponding to that claimed. Porter is alleged to show a distance between a plane, including the distal end of an edge (edge of Part 26) and the distal end of the shoulder (edge of shoulder 18) being greater than the width of at least one of the cheek. However, in such a case, there are no upstanding lips and it is not even recognized how the Larrea reference would be proposed to be combined with the other references relied upon. For the foregoing reasons, a mere dimension as purportedly shown by Porter, is insufficient to suggest or disclose the claimed invention.

ii. Dependant Claims 7 and 21

Claims 7 and 21 depend from claim 1 and recite glue or adhesive tape coating at least a part of the joining profile. In rejecting these claims, the Office Action recognizes that the primary reference fails to teach or suggest “the joining profiles being partially coated with glue or adhesive tape,” but, the Office Action continues, such a modification would have been obvious “because it would ensure the joining of the floorboards to the joining profiles.”

However, the cited references fail to establish *prima facie* obviousness. As recited by MPEP § 2143.01, in order to establish obviousness, a teaching, motivation or suggestion to make the modification must be found in the prior art. The Office Action fails to identify any teaching, motivation or suggestion in the prior art to coat at least part of the joining profile with glue or adhesive tape.

iii. Dependant Claim 12

Claim 12 depends from claim 1 and recites the top surface of the floor board is flush with the top surface of an adjacent floor board, and the lower sides of the floor board are flush with the joining profile. In rejecting this claim, the Office Action simply states, “Svenska as modified shows the lower sides of the floorboard being flush with the joining profile.”

Again, the cited references fail to establish *prima facie* obviousness. As recited by MPEP § 2143.01, in order to establish obviousness, a teaching, motivation or suggestion to make the modification must be found in the prior art. The Office Action fails to identify any teaching, motivation or suggestion in the prior art to modify the joining profile of Svenska to reach the

subject matter of claim 12. In fact, in rejecting claim 12, the Office Action does not even attempt to identify any motivation at all to modify the invention of Svenska to provide the lower sides of the boards flush with the joining profile.

C. Claims 6, 13 and 14 stand rejected under 35 USC § 103(a) as being unpatentable over Svenska in view of Glover et al.

The Office Action asserts Svenska teaches each feature recited by these claims, except for the central cheek being first and second resilient cheeks, for which purpose Glover et al. is cited.

i. Independent Claim 13

In rejecting claim 13, the Office Action states that it would have been obvious to modify the joining profile of Svenska by splitting the central cheek into two separate resilient cheeks, as shown in Fig. 7 of Glover et al., as “having first and second resilient cheeks in place of a single cheek would enable the easy snap fitting of the tongues into the notches.”

However, the material used in the formation of the device shown in Fig. 7 of Glover et al. is not described as being resilient. In fact, when a facing surface of a wall urges projections 106 apart, the projections “become embedded in the material of the panels.” Such embedding is certainly not a snap. See column 5, lines 41-45. As a result, Glover et al. cannot provide any motivation to modify Svenska to “enable easy snap fitting of the tongues into the notches.” It appears that the Examiner is impermissibly using the Applicants’ disclosure for the required motivation.

ii. Dependent Claim 14

Claim 14 depends from claim 13 and recites the resilient cheeks are separated by a space, the space being large enough to permit deflection of one the resilient cheeks without contacting the other cheek.

In rejecting this claim, the Office Action merely states that Svenska, as modified by Glover et al., shows the claimed feature. However, there is no discussion in Glover et al. that the walls 104 and 105 are deflected at all. In fact, as discussed above, upon pressure, the projections

106 at the ends of walls 104 and 105, rather than deflect (as recited by the claim) “become embedded in the material of the panels.”

D. Claims 22 and 24 stand rejected under 35 USC § 103(a) as being unpatentable over Svenska in view of Glover et al.

Claims 22 and 24 depend from claim 13 and recite the material of the joining profile being an extruded thermoplastic material and an injection molded material, respectively. The Office Action recognizes that the primary reference fails to teach or suggest such features. However, in rejecting these claims, the Office Action states it would have been obvious to modify the structure of Svenska to “show the material being an extruded thermoplastic material, or the material being an injection molded material because extrusion and injection molding plastic material are well known material in the profile art as light weight and rust resistant [*sic*].”

Again, the cited references fail to establish *prima facie* obviousness. As recited by MPEP § 2143.01, in order to establish obviousness, a teaching, motivation or suggestion to make the modification must be found in the prior art. The Office Action fails to identify any teaching, motivation or suggestion in the prior art to make the joining profile lightweight and rust resistant.

Moreover, it is not evident why rust resistance and/or weight are relevant to the joining profile of Svenska. As discussed in the final paragraph of the translation of Svenska, there is no gap between the panels. Because water cannot penetrate the joint (having no gap), and cannot reach the joining profile, it is not understood why one of ordinary skill would be concerned with rusting of the joining profile. Similarly, there is no discussion in either of the references, or otherwise identified in the art, why one of ordinary skill should consider the weight of the joining profile for any reason.

E. Claim 23 stands rejected under 35 USC § 103(a) as being unpatentable over Svenska in view of Glover et al.

Claim 23 depends from claim 13 and adds the feature that the thermoplastic material is a polyolefin. Although the cited references fail to teach or suggest to select a polyolefin as the

thermoplastic material, the Office Action claims that such a further modification of Svenska would have been within the general skill of a worker in the art. However, as further stated by MPEP § 2143.01, “A statement that modifications of the prior art to meet the claimed invention would have been ‘well within the ordinary skill of the art’ at the time the claimed invention was made’ ... is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings” (citing *Ex parte Levengood*, 28 USPQ2d 1300 (BPAI 1993), *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000), and *Al-Site Corp. v. VSI Int’l Inc.*, 174 F.3d 13087, 50 USPQ2d 1161 (Fed. Cir. 1999)) (emphasis in original). The Examiner has not presented any “objective reason” to utilize a polyolefin as the plastic material.

Moreover, as discussed above, because the combination of the teachings of Svenska and Glover et al. fails to render claim 13 unpatentable, the same references cannot render this claim unpatentable as well.

VIII. CONCLUSION

As the Examiner has failed to identify in the cited art each feature recited by the present claims, or in the alternative, establish why one of ordinary skill in the art would be motivated to modify the prior art, Appellant urges the Examiner committed reversible error in finally rejecting the claims of this application as being anticipated and/or unpatentable over the cited art.


APPENDICES

The following Appendices are attached to and made part of this brief:

Appendix	Claims on Appeal
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Respectfully submitted,

Date: MAY 12, 2005
TPP/EPR:mat
Attorney Docket No.: TPP31386

 *Res. No. 45,047*
for Thomas P. Pavelko
Registration No. 31,689

STEVENS DAVIS, MILLER & MOSHER L.L.P.
1615 L Street, N.W., Suite 850
Washington, D.C. 20036
Telephone: (202) 785-0100
Facsimile: (202) 408-5200



APPENDIX

CLAIMS ON APPEAL

1. A floor comprising:
a plurality of floor boards, each of said floor boards comprising edges, at least one of said edges having a distal end lying in a vertical plane, a lower side, a decorative top surface, a notch formed in said edge below said decorative upper surface, wherein at least part of said notch is defined by a shoulder, said shoulder terminating in a distal end, whereby the floor boards are joinable by means of separate joining profiles, wherein at least one of said edges is provided with at least one groove, which groove is arranged parallel to its respective edge, and that the joining profiles comprise lips arranged in pairs, which lips are parallel and each extend in the same direction and said joining profile and lips, when inserted into said groove, do not extend beyond said lower side, and said lips are received by the at least one groove of a respective floor board so that adjacent floor boards with the grooves at the adjacent edges are guided and fixed horizontally by the lips of the joining profile, which lips are connected to each other by a middle section of the joining profile and that the joining profile is provided with a central cheek section which is comprised by a first resilient cheek and a second independently resilient cheek, each of said cheeks having a width and one tongue, and each tongue terminates at its respective resilient cheek, whereby each tongue is received by said notch so that adjacent floor boards are fixed in a vertical direction and wherein a distance between said plane including the distal end of the edge and said distal end of the shoulder is greater than the width of at least one of the first and second cheeks.
2. The floor according to claim 1, wherein the groove of the floor board is on the lower side and is arranged at a distance from the closest edge less than half of the width of a floor board.
3. The floor according to claim 2, wherein the floor boards are provided with a groove at the edges and that the distance between each groove and the closest edge is about the same.
4. The floor according to claim 2, wherein the part of the floor board located between

each edge and its respective groove is thinner than the maximum thickness of the floor board by means of a recess located on the lower side.

5. The floor according to claim 1, wherein the distance between a center of one lip to a center of the second lip of the joining profile is less than the distance between a center of one groove on a first board to a center of a second groove on an adjacent board.

6. Joining profile according to claim 13, wherein the joining profiles are manufactured in long sections exceeding the length of a floor board which may be cut into a desired length.

7. The floor according to claim 1, wherein the joining profiles are partially coated with glue or adhesive tape.

8-10. (Cancelled)

11. The floor according to claim 1, wherein the grooves on the lower side are arranged at a distance from the closest edge less than one quarter of the width of the floor board.

12. The floor according to claim 1, wherein the top surface of the floor board is flush with the top surface of an adjacent floor board, and the lower sides of the floor board are flush with the joining profile.

13. Joining profile comprising:

two upstanding lips extending parallel to each other in the same direction, disposed at opposite ends of and perpendicular to a planar, longitudinally extending middle section having a midpoint, such that the middle section terminates with the upstanding lips;

a central cheek section located substantially at the midpoint of the middle section, said central cheek section comprising first and second independently resilient cheeks, wherein the cheeks extend in the same direction as the lips, and not below the middle section;

each of said first and second resilient cheeks comprising a tongue, extending perpendicular with respect to said respective cheek;

wherein the joining profile is formed from a material selected from the group consisting of a thermoplastic, polystyrene, polyvinyl chloride and acrylonitrile-butadiene-styrene copolymer.

14 Joining profile according to claim 13, wherein said first and second resilient cheeks are separated by a space, said space being large enough to permit deflection of one of said first and second resilient cheeks without contacting the other of said first and second resilient cheeks.

15-19. (Cancelled)

20. The floor according to claim 1, wherein the upper surface of the floor boards have a shape selected from the group consisting of square, rhombus and rectangle.

21. The floor according to claim 1, wherein the floor boards are partially coated with glue.

22. (Previously Presented) Joining profile according to claim 13, wherein the material is an extruded thermoplastic material.

23. (Previously Presented) Joining profile according to claim 13, wherein the thermoplastic material is a polyolefin.

24. (Previously Presented) Joining profile according to claim 13, wherein the material is an injection molded material.